IN THE

Supreme Court of the United States

October Term, 1969

No. 1559

STOCKHAM VALVES AND FITTINGS, INC.,

Petitioner,

versus

ARTHUR J. SCHMITT FOUNDATION and MORRIS BEAN & COMPANY,

Respondents.

PETITIONER'S REPLY BRIEF

Statement

Respondents, in urging this Court to deny the petition for certiorari, incorrectly state that no issue of law is involved here because, it is said, the lower courts have specifically applied in this case the standard of patentability enunciated by this Court in *Graham* v. *John Deere Company*, 383 U.S. 1 (1966). This assertion, a standard response in opposition to a petition for certiorari, wholly ignores the following facts which bear significantly upon the issue of whether the courts below have failed to make the prescribed independent factual inquiries *required by this Court* in the *Graham* case:

¶ The opinion of the District Court was adopted substantially *in toto* from Respondents' proposed

findings of fact which, not unexpectedly, made no reference whatsoever to the *Foundry Trade Journal* article and the *Less et al.* patent. Thus, the District Court never discussed and presumably did not consider these anticipating references but confined itself, instead, in what Respondents describe as an 'unusually detailed' opinion, to a consideration only of that prior art which Respondents classified as being 'the more relevant' on the issue of validity of the Bean patents.

¶ Respondents' assertion that it would be 'absurd to suggest' that the *Foundry Trade Journal* article and the *Less et al.* patent were 'overlooked' by the Court of Appeals merely because that court wrote only a *per curiam* opinion totally ignores the fact that that Court failed to *rule* on this material evidence. Certainly, with so much attention focused on this evidence, as Respondents admit, the Court of Appeals, in the absence of any such ruling in the District Court, had the *duty* to specifically treat with and rule on this evidence.

¶ Finally, in utter frustration, Petitioner filed in the Court of Appeals a Petition for Rehearing *En Banc*, and again, specifically focused its attention on this evidence so that it might, in all fairness, be considered and ruled on by the Court. That Court, however, held this petition for almost fourteen months before denying it without comment."

Thus, despite Respondents' assertion that the courts below have considered this evidence, despite the unfounded charges that Petitioner has "misdescribed" both the prior art and the patented invention and despite Respondents' discussions as to what this prior art evidence shows, the fact remains that no court of law has yet to make an *independent consideration* of this evidence as reflected by the opinions below and, therefore, presents for resolution by this Court a substantial issue of law, that issue being:

Must the courts, in making the factual inquires prescribed by this Court in the *Graham* case, specically rule on material evidence which is introduced

for the purpose of invalidating a patent for anticipation under 35 U.S.C. § 102 and, *a fortiori*, for obviousness under 35 U.S.C. § 103? We believe that the absence of such a ruling by the courts leaves open the question as to whether such inquiry has in fact been made and reflects a failure to comply affirmatively, rather than by indirection, with the mandate of this Court in *Graham*.

This Court, after a period of fourteen years, granted certiorari in three patent cases, *Graham* v. *John Deere Co., Calmar, Inc.* v. *Cook Chemical Co.*, and *Colgate-Palmolive Co.* v. *Cook Chemical Co.*, reported together at 383 U.S. 1 (1966), and set forth for the *nisi prius* and appellate courts the standard which it thought should be uniformly applied to the test of invention. The District Court in Alabama and the Court of Appeals for the Fifth Circuit have plainly not followed the mandate of this Court in the instant case. The prior art, which was not, as far as the opinion of any court reveals, considered in the factual inquiry required by *Graham*, is asserted in this case not only as reflecting the state of the art on the question of invention, but also was in fact asserted as directly anticipating, such as to create a statutory bar against patentability.

Respondent states that Petitioner "seeks only a review of findings of fact which were concurred in by both of the courts below." Nothing could be further from the truth and nothing so far misses the mark as to what this petition is about as does that statement. Petitioner urges this Court to grant this petition not to review findings of fact made below—the pertinent facts were not found—but to decide the important issues of law which are raised herein and which should be decided in the interests of the uniform interpretation and application of the patent laws of the United States.

CONCLUSION

This Petition for a Writ of Certiorari to the United States Court of Appeals for the Fifth Circuit should be granted.

Dated: June 2, 1970

Respectfully submitted,

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Certificate of Service

I certify that a copy of the foregoing Petitioner's Reply Brief was mailed to Leigh M. Clark, Esq., Cabaniss, Johnston, Gardner & Clark, Birmingham, Alabama, and a copy was delivered to William C. Conner, Esq., Curtis, Morris and Safford, New York, New York, attorneys and counsel for Respondents this 2nd day of June, 1970.

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